

### **REMARKS**

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-31 and 63 are currently pending in the application and subject to examination.

In the Office Action mailed August 2, 2006, Claims 1-2, 7-8, 10-13, 18-19, 22-24, 26-29, and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,093,718 to Hoarty et al. ("Hoarty") in view of U.S. Patent No. 5,506,902 to Kubota ("Kubota") in further view of U.S. Patent No. 5,624,265 to Redford et al. ("Redford"); claim 3 as being unpatentable over Hoarty in view of Kubota, in view of Redford in further view of U.S. Patent no. 5,210,611 to Yee et al. ("Yee"); claims 4-5 and 20-21 as being unpatentable over Hoarty in view of Kubota, in view of Redford in further view of U.S. Patent No. 5,632,022 to Warren et al. ("Warren"); claim 6 as being unpatentable over Hoarty in view of Kubota in view of Redford in further view of U.S. Patent No. 4,361,848 to Poignet et al. ("Poignet"); and claims 9, 14-17, 25, and 30-31 as being unpatentable over Hoarty in view of Kubota in view of Redford in further view of U.S. Patent No. 5,475,399 to Borsuk ("Borsuk"). The Applicants hereby traverse the rejections as follows.

Applicants' invention as set forth in claim 1 is directed to a system for transmitting and receiving text, and displaying an indication of the text, wherein the text is transmitted on an electronic signal, including a home subsystem that includes a library including an electronic collection of electronic books, ordered and transmitted electronically via a transmitter, wherein in response to a transmitted order, the ordered

electronic book is transmitted from a remote operations center to the home subsystem and stored in the library unit of the home subsystem until a selection is received to view the electronic book.

The Office Action cites Kubota as teaching a library that stores an electronic collection of books. However, the Office Action admits that Hoarty and Kubota fail to teach that electronic books can be ordered and transmitted electronically via a transmitter. The Office Action relies on Redford as disclosing this feature.

The Applicants submit that Redford does not disclose or suggest at least the combination of an electronic collection of electronic books, ordered and transmitted electronically via a transmitter, wherein in response to a transmitted order, the ordered electronic book is transmitted from a remote operations center to the home subsystem and stored in the library unit of the home subsystem until a selection is received to view the electronic book, as recited in claim 1.

Instead, the referenced section of Redford merely teaches access and display of electronic books. Redford teaches that the electronic books may be accessed from a remote server or from a local storage media 119 (such as a CD-ROM). (See column 15, lines 30-46). Redford does not disclose or suggest, for example, that the electronic books are ordered, transmitted, and stored in a home subsystem from the remote server, until a selection is received to view the electronic book, as recited in claim 1.

Therefore, the Applicants submit that none of Hoarty, Kubota, or Redford, disclose or suggest a system for transmitting and receiving text including at least the combination of a library including an electronic collection of electronic books, ordered and transmitted electronically via a transmitter, wherein in response to a transmitted

order, the ordered electronic book is transmitted from a remote operations center to a home subsystem and stored in a library unit of the home subsystem until a selection is received to view the electronic book, as claimed in amended claim 1.

Yee, Warren, Poignet, and Borsuk fail to cure the deficiency in Redford, Hoarty, and Kubota.

For at least this reason, the Applicants submit that claim 1 is allowable over the cited art. For similar reasons, the Applicants submit that claims 18 and 63 are likewise allowable.

Claims 2-17 and 19-31 depend from claims 1 and 18 and include further limitations. As claims 1, 18, and 63 are allowable, the Applicants submit that claims 2-17, and 19-31, which depend from claims 1 and 18 are likewise allowable for at least this reason.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish

obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 5. This is an insufficient showing of motivation.

### **CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to

Application No. 09/237,827  
Attorney Docket No. 026880-00013

Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00013.

Respectfully submitted,

Arent Fox LLP

A handwritten signature in black ink, appearing to read "Sheree Rowe", with a stylized flourish at the end.

Sheree T. Rowe  
Attorney for Applicants  
Registration No. 59,068

**Customer No. 004372**  
1050 Connecticut Ave., N.W.  
Suite 400  
Washington, D.C. 20036-5339  
Telephone No. (202) 715-8492  
Facsimile No. (202) 857-6395